

REMARKS

At the time of the First Office Action dated February 12, 2009, claims 1, 13, and 20 were pending and rejected in this application. Claims 21-37 have been added and correspond substantially to the claims cancelled in the Preliminary Amendment dated May 23, 2008.

CLAIMS 1 AND 13 ARE REJECTED UNDER 35 U.S.C. § 101

On pages 5 and 6 of the First Office Action, the Examiner asserted that the claimed invention, as recited in claims 1 and 13, fails to meet the requirements of 35 U.S.C. § 101. This rejection is respectfully traversed.

Although Applicants disagree with the Examiner's implied assertion that independent claims 1 and 13 are not directed to statutory subject matter, independent claim 1 has been amended to recite a "method for ranking services in a web services computer hardware architecture." As such, at the very least, independent claim 1 is tied to a machine (i.e., a web services computer hardware architecture) and meets the 'machine or transformation' test described within In re Bilski, 545 F.3d 943 (Fed. Cir. 2008) (en banc).

Similarly, although Applicants disagree with the Examiner's implied assertion that independent claim 13 is not directed to statutory subject matter, independent claim 13 has been amended to recite a "web services computer hardware architecture." Thus, claim 13 is clearly directed to a machine/device.

For the above-described reasons, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1 and 13 under 35 U.S.C. § 101.

CLAIM 13 IS REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

On page 4 of the First Office Action, the Examiner identified a perceived informality generating an antecedent basis issue. This rejection is respectfully traversed.

The Examiner asserted that "the hierarchy" in line 4 of claim 13 and "the ranker machine" in line 14 of claim 13 lacks antecedent basis. With regard to the term "the ranker machine," Applicants note that this term is no longer in claim 13, and thus, the Examiner rejection is moot. With regard to "the hierarchy," the Examiner's is directed to the claimed "*a hierarchy* of services" recited in line 3 of claim 13. As such, proper antecedent basis is found in claim 13 for "the hierarchy."

For the above-described reasons, Applicants respectfully solicit withdrawal of the imposed rejection of claim 13 under 35 U.S.C. § 101.

CLAIMS 1, 13, AND 20 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON MENDELEVITCH ET AL., U.S. PATENT PUBLICATION NO. 2003/0130993 (HEREINAFTER MENDELEVITCH)

On pages 6-10 of the First Office Action, the Examiner concluded that one having ordinary skill in the art would have considered the claimed invention to be obvious in view of Mendelevitch. This rejection is respectfully traversed.

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2 On October 10, 2007, the Patent Office issued the "Examination Guidelines for
3 Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR
4 International Co. v. Teleflex Inc.," 72 Fed. Reg. 57,526 (2007) (hereinafter the Examination
5 Guidelines). Section III is entitled "Rationales To Support Rejections Under 35 U.S.C. 103."
6 Within this section is the following quote from the Supreme Court: "rejections on obviousness
7 grounds cannot be sustained by merely conclusory statements; instead there must be some
8 articulated reasoning with some rational underpinning to support the legal conclusion of
9 obviousness." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*,
10 441 F.3d 977, 988 (Fed. Cir. 2006)).

11
12 Referring to the first column on page 57,529 of the Examination Guidelines for
13 Determining Obviousness, the following is a list of rationales that may be used to support a
14 finding of obviousness under 35 U.S.C. § 103:

15 (A) Combining prior art elements according to known methods to yield
16 predictable results;

17 (B) Simple substitution of one known element for another to obtain
18 predictable results;

19 (C) Use of known technique to improve similar devices (methods, or
20 products) in the same way;

21 (D) Applying a known technique to a known device (method, or product)
22 ready for improvement to yield predictable results;

23 (E) "Obvious to try" - choosing from a finite number of identified,
24 predictable solutions, with a reasonable expectation of success;

25 (F) Known work in one field of endeavor may prompt variations of it for
26 use in either the same field or a different one based on design incentives or other

1 market forces if the variations would have been predictable to one of ordinary
2 skill in the art;

3 (G) Some teaching, suggestion, or motivation in the prior art that would
4 have led one of ordinary skill to modify the prior art reference or to combine prior
5 art reference teachings to arrive at the claimed invention.
6

7 Upon reviewing the Examiner's analysis on pages 6 and 7 of the Second Office Action, the
8 Examiner appears to be employing rationale (B). If the Examiner is not relying upon rationale
9 (B), Applicants request that the Examiner clearly identify the rationale, as described in the
10 Examination Guidelines for Determining Obviousness, being employed by the Examiner in
11 rejecting the claims under 35 U.S.C. § 103.
12

13 Referring to again rationale (B), as discussed on page 57,530 of the Examination
14 Guidelines, the following findings of fact must be articulated by the Examiner:

15 (1) a finding that the prior art contained a device (method, product, etc.)
16 which differed from the claimed device by the substitution of some components
17 (step, element, etc.) with other components;

18 (2) a finding that the substituted components and their functions were
19 known in the art;

20 (3) a finding that one of ordinary skill in the art could have substituted one
21 known element for another, and the results of the substitution would have been
22 predictable; and

23 (4) whatever additional findings based on the *Graham* factual inquiries
24 may be necessary, in view of the facts of the case under consideration, to explain
25 a conclusion of obviousness.
26

27 Referring to the paragraph entitled "Office Personnel as Factfinders" on page 57,527 of
28 the Examination guidelines, the following was stated:

Office personnel fulfill the critical role of factfinder when resolving the *Graham* inquiries. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual. When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

In Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court set forth the factual inquiries that are to be applied when establishing a background for determining obviousness under 35 U.S.C. 103. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of the prior art;
- (B) Ascertain the differences between the prior art and the claims at issue;
- (C) Resolve the level of ordinary skill in the pertinent art; and
- (D) Evaluate any indicia of nonobviousness.

However, in order to make a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed. See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994). See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, ... will normally control the remainder of the decisional process.") See Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

1 Upon reviewing the Examiner's analysis in view of the requirements discussed above
2 necessary for the Examiner to establish a prima facie case of obviousness, Applicants recognize
3 numerous deficiencies in the Examiner's analysis.
4

5 At the outset, Applicants note that the Examiner's sole cited reference is non-analogous
6 prior art. Whether a prior art reference is from a nonanalogous art involves (a) determining
7 whether the reference is within the same field of endeavor and (b) determining whether the
8 reference is reasonably pertinent to a known problem in the art. In re Clay, 23 USPQ2d 1058
9 (Fed Cir. 1992). If the prior art is outside the inventor's field of endeavor, the inventor will only
10 be presumed to have knowledge of prior art that is reasonably pertinent to a known need or
11 problem in the field of endeavor. KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 82
12 USPQ2d 1385, 1397 (2007). The Examiner is also charged to consider "the reality of the
13 circumstances' ... in other words, common sense" to determine what field a person of ordinary
14 skill in the art would reasonably be expected to look. In re Oetiker, 977 F.2d 1443, 24 USPQ2d
15 1443 (Fed. Cir. 1992). With regard to this issue, the Examiner is also referred to M.P.E.P. §
16 2141.01, entitled "Analogous and Nonanalogous Art."
17

18 In the present instance, whereas the claimed invention is directed to ranking services in a
19 web services architecture, Mendelevitch is directed to categorizing incoming documents into
20 topics. These are entirely different fields of endeavors. Since the Examiner has failed to
21 establish that Mendelevitch is reasonably pertinent to a known need or problem in the field of
22 endeavor, Mendelevitch is non-analogous prior art that cannot be properly applied against the
23 claimed invention. That Mendelevitch is non-analogous prior art is supported by the large list of

1 items that, on page 8 of the First Office Action, the Examiner admits that Mendelevitch fails to
2 teach.

3
4 Not only does the Examiner admit that Mendelevitch fail to teach many of the claimed
5 limitations, the Examiner has failed to discharge the duty of performing a proper Graham
6 analysis. Specifically, the Examiner has both failed to properly characterize the scope and
7 content of the applied prior art and failed to properly ascertain the differences between the
8 applied prior art and the claims at issue. On pages 6 and 7 of the First Office Action, the
9 Examiner continually refers to Mendelevitch as teaching certain limitations associated with
10 "services." However, none of the teachings being relied upon by the Examiner are teach the
11 "services," as claimed. The passages cited by the Examiner deal with documents, not services.

12
13 As another example, claim 1 recites "indicating a preference regarding at least one
14 service," for which the Examiner cited paragraphs [0014] and [0047] of Mendelevitch. Although
15 paragraph [0014] refers to a "user configurable threshold," there is no disclosure that this user
16 configurable threshold (presumably corresponding to the claimed "preference") regards at least
17 one service (or even document). Instead, the configurable threshold appears to be unrelated to
18 any service or document.

19
20 Regarding the claimed "finding a set of possible lower-level services, by a service, using
21 a directory at each level of the hierarchy," on page 6 and 7 of the First Office Action, the
22 Examiner cited paragraph [0013] and claim 13 while also stating "a set of documents are
23 searched through a database [directory] which is arranged in a hierarchy structure." The

Examiner's disregard for the precise language of the claims is astounding. For example, the language refers to using a director at each level of the hierarchy. However, this concept has been complete ignored within the Examiner's analysis. The claim language also refers to a service finding lower-level services. This concept is also ignored within the Examiner's analysis.

Applicants have found other mischaracterizations as to the teachings of Mendelevitch and the differences between Mendelevitch and the claims. However, an identification of these additional mischaracterizations is unnecessary and redundant given the already identified deficiencies of Mendelevitch.

Referring to page 8 of the First Office Action, Applicants are incredulous that the Examiner would assert:

However, the Examiner asserts that the data stored in the directory is directed to non-functional descriptive subject matter. That is to say, the type of data, i.e., lower-level services, level of services, service requestors, and service providers, does not affect how the method is stored or stores the information. The type of data adds little, if anything, to the claim's structure, and thus, does not serve as a limitation on the claims to distinguish over the prior art. As claimed the steps of the invention would be performed in the same manner regardless of the type of data that is being processed or stored.

When determining whether a claim is obvious, an examiner must make "a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art." In re Ochiai, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, "obviousness requires a suggestion of all limitations in a claim." CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing In re Royka, 490 F.2d 981, 985 (CCPA 1974)). By refusing to give patentable weight to all the limitations at issue, the Examiner has committed clear legal error.

1 Notwithstanding the Examiner committing legal error by failing to consider all of the
2 limitations of the claim, the Examiner's analysis is predicated upon wrong assumptions. The
3 type of data being processed, stored, manipulated, etc., absolutely affects how any particular
4 method involving those steps. For the Examiner to infer otherwise evidences an exceptional lack
5 of knowledge with regarding to computer-implemented devices/methodology. If, for example,
6 the expected data is not in the form required for processing/storing/manipulating, then an error
7 can occur and/or the data is not proper processed/stored/manipulated. In a more particular
8 example, if a method of numerically adding two inputs receives, as inputs, the letters "j" and "k,"
9 then the adding step will not be performed.

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11 For the above-described reasons, the Examiner has failed to establish that the claimed
12 invention, as recited in claims 1, 13, and 20, would have been obvious within the meaning of 35
13 U.S.C. § 103. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of
14 claims 1, 13, and 20 under 35 U.S.C. § 103 for obviousness based upon Mendelevitch.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: May 12, 2009

Respectfully submitted,

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